



LH 005

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Catherine LIN-HENDEL

Ser. No.: **09/619,255**

Filed: **July 19, 2000**

For: **SYSTEM AND METHOD FOR
INTERACTIVE, COMPUTER ASSISTED
PERSONALIZATION OF
ON-LINE MERCHANDISE PURCHASES**

Group Art Unit: **3625**

Examiner: **Mark A. FADOK**

Attorney File No.: **LH 005**

Final Office Action Mailed On:

October 24, 2005

**APPEAL BRIEF TO THE
BOARD OF PATENT APPEALS AND INTERFERENCES**

This Appeal Brief is responsive to the rejection in Final Office Action mailed on October 24, 2005, in the above-referenced patent application. It is being filed within two months of mailing of an Office action responsive to the Pre-Appeal Brief Request for Review filed in this case. Applicant petitions for a one month extension of time under 37 CFR § 1.136(a)(3), and authorization is hereby granted to charge all required extension of time fees under 37 CFR § 1.17 to Deposit Account No. 50-3196. This filing is therefore timely. If the Applicant's attorney is mistaken in this regard, Applicant conditionally petitions for an additional extension of time, and authorization is hereby

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I
REAL PARTY IN INTEREST

In this Appeal, the real party in interest is Dr. Catherine Lin-Hendel, an individual.

II
RELATED APPEALS AND INTERFERENCES

Applicant-Appellant and the undersigned legal representative do not know of any other appeal, interference, or judicial proceeding that is related to, directly affects, is directly affected by, or has a bearing on the decision of the Board of Patent Appeals and Interferences in this Appeal.

III
STATUS OF CLAIMS

The status of claims in the instant application is as follows:

Claims 1-10 and 12-22 are pending.

Claims 1-10 and 12-21 have been rejected.

Claim 22 has been withdrawn from consideration.

Applicant appeals from the rejection of claims 1-10 and 12-21.

IV
STATUS OF AMENDMENTS

No amendments have been filed after the rejection of claims in the Final Office Action mailed on October 24, 2005.

V
SUMMARY OF CLAIMED SUBJECT MATTER

A. Independent Claim

Claim 1

Claim 1 is directed to an electronic system for purchasing merchandise online using a computer having a display device. *E.g.*, Specification at 1, lines 17-20; *id.* at page 8, line 10 through page 9, line 2; *id.* page 16, line 22 through page 17, line 1; *id.* page 18, lines 21-22; *id.* at page 20, lines 4-8.

The system includes means for selecting and purchasing merchandise, by a user, online. *E.g.*, Specification at 1, lines 17-20; *id.* page 15, lines 15-23; *id.* page 16, lines 10-13; *id.* page 20, lines 14-15; *id.* page 22, lines 2-6; *id.* page 23, lines 14-22; Figure 8.

The system also includes an interactive wizard guide, selectively and optionally deployed by the user, for making online merchandise recommendations and computer-assisted selections tailored to said user. *E.g.*, Specification at page 8, line 10 through page 9, line 2; *id.* page 15, line 15-23; *id.* page 16, line 5 through page 17, line 2; *id.* page 23, lines 14-22.

The interactive wizard guide includes means for prompting the user to specify preferences regarding at least one type of merchandise of interest to said user, said prompting means includes means for prompting the user to answer a plurality of questions; and means for receiving the preferences and answers to the plurality of questions to create a user profile. *E.g.*, Specification at 8, line 10 through page 9, line 2; *id.* page 15, lines 15-19; *id.* page 16, lines 20-22; *id.* page 19, lines 11-18; *id.* page 20, lines 4-5, 9-11, and 18-22; *id.* page 21, lines 9-10 and 18-22; *id.* page 22, lines 8-12, 15-19, and 21-23; *id.* page 23, lines 1-2, and 14-22; Figure 9A1, steps 1 and 3.

The interactive wizard guide further includes means for searching in and retrieving data from at least one database using predetermined intelligence rules together with said user profile to determine said recommendations and said selections of said merchandise and accessories to said merchandise. *E.g.*, Specification at page 8, line 15 through page 9, line 2; *id.* page 15, lines 15-23; *id.* page 16, lines 14-18; *id.* page 17, lines 8-20; *id.* page 22, lines 19-20; *id.* page 23, lines 14-22.

The interactive wizard guide further includes means, in response to said retrieving means, for displaying on said display device, said recommendations and said selections of said merchandise and said accessories. *E.g.*, Specification at page 8, line 15 through page 9, line 2; *id.* page 18, lines 16-22; *id.* page 20, lines 4-8; *id.* page 21, lines 11-17; *id.* page 22, lines 8-13; *id.* page 23, lines 7-10 and 14-22.

The interactive wizard guide further includes means for overriding said interactive wizard guide. *E.g.*, Specification at 22, lines 20-21; *id.* page 23, lines 14-22.

B. Dependent Claim

Claim 4

Claim 4 is directed to the system of claim 1. The system further includes means for providing the user with names of a plurality of vendors for the merchandise recommended to the user. *E.g.*, Specification at 18, lines 1-2; *id.* at page 23, lines 14-22; Figure 9A1, step 3 (“Maker Menu” on the right side).

VI
CONCISE STATEMENT OF THE GROUNDS OF REJECTION

1. Claims 1, 3-5, 9, 10, 16, and 20 apparently¹ stand rejected under 35 U.S.C. 103(a) as being unpatentable over Danish *et al.*, U.S. Patent Number 6,327,588 (“Danish” hereinafter) in view of Official Notice.
2. Claims 2, 6-8, 12-15, and 17-19 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Danish in view of Official Notice and in further view of Weaver, U.S. Patent Number 6,404,426 (“Weaver” hereinafter).
3. Claim 21 apparently² stands rejected under 35 U.S.C. 103(a) as being unpatentable over Danish in view of Official Notice, Weaver, and Hashimoto, U.S. Patent Number 5,729,699 (“Hashimoto”).

¹ The Final Office Action and the immediately preceding Office Action rejected claims 1, 3-5, 9, 10, 16, and 20 “under 35 U.S.C. 103(a) as being unpatentable over Danish *et al.* (6,412,012) in view of Official Notice.” The applicants in United States Patent Number 6,412,012 were Bieganski *et al.*, not Danish *et al.* The Bieganski patent was used as a basis for rejections in one of the previous Office Actions, which rejections were overcome. On the other hand, Danish is also used as a basis for rejections of dependent claims made in the Final Office Action and in the immediately preceding Office Action. It appears therefore that citing “Danish *et al.* (6,412,012)” was a clerical error in the Final Office Action, and the intended reference was U.S. Patent Number 6,327,588.

² The Final Office Action and the immediately preceding Office Action rejected claim 21 “under 35 U.S.C. 103(a) as being unpatentable over Danish *et al.* (6,412,012) in view of Official Notice in view of Weaver and further in view of Hashimoto (5,729,699).” For the reasons explained in note 1 *supra*, it appears that citing “Danish *et al.* (6,412,012)” was a clerical error in the Final Office Action, and the intended reference was U.S. Patent Number 6,327,588.

VII ARGUMENT

A. Rejection of Independent Claims 1

Claims 1, 3-5, 9, 10, 16, and 20 were rejected as being unpatentable over Danish in view of Official Notice. The Final Office Action asserted that Danish discloses all the features of claims 1, 3-5, 9, 10, 16, and 20, without mentioning the Official Notice. In the single paragraph rejecting these claims, the Final Office Action did not explain what facts were noticed in the Official Notice. If the assertion that “Danish discloses all the features” means that Danish discloses a single embodiment with all the features recited in the claims, then there should have been no need for the use of Official Notice.

The rejection was made under section 103. It follows that not all the limitations recited in the claims are found in the same embodiment of a single prior art reference. The Final Office Action, however, did not explain what elements need to be added to Danish, or what elements disclosed in Danish need to be modified, in order to obtain the system recited in claim 1. The Final Office Action thus failed to provide any motivation for the attempted modification and/or combination.

The Patent and Trademark Office has the burden of making a *prima facie* case of obviousness under 35 U.S.C. § 103. *E.g.*, *In re Mayne*, 104 F.3d 1339, 1342, 41 U.S.P.Q.2d 1451, 1454 (Fed. Cir. 1997); MPEP § 2142. There are three basic requirements for establishing a *prima facie* case of obviousness. MPEP § 2143. First, the combination of prior art references must teach or suggest all the claim limitations. *Id.* Second, there must be a reasonable expectation of success. *Id.* Third, there

also “must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or to combine reference teachings.” *Id.* Both the suggestion and the reasonable expectation of success must be founded in the prior art, not in the Applicant’s disclosure. *In re Vaeck*, 947 F.2d 488, 493, 20 U.S.P.Q.2d 1438, 1442 (Fed. Cir. 1991). “When the motivation to combine the teachings of the references is not immediately apparent, it is the duty of the examiner to explain why the combination of the teachings is proper.” MPEP § 2142 (citing *Ex parte Skinner*, 2 U.S.P.Q.2d 1788 (Bd. Pat. App. & Inter. 1986)). Here, the Final Office Action failed to explain (1) what elements need to be combined and/or modified, (2) what would have motivated a person skilled in the art to make the needed modification(s) and/or combination(s), (3) which references disclose the requisite motivation to make the needed modification(s) and/or combination(s), and (4) which references disclose the reasonable expectation of success in making the needed modification(s) and/or combination(s). Therefore, the Final Office Action failed to establish a *prima facie* case of obviousness of claim 1.

Danish, the main reference here, also fails to teach or suggest all the claim limitations. For convenience of discussion, independent claim 1 is set forth below:

1. (Previously Presented) An electronic system for purchasing merchandise online using a computer having a display device, comprising:

means for selecting and purchasing merchandise, by a user, online; and

an interactive wizard guide, selectively and optionally deployed by the user, for making online merchandise recommendations and computer-assisted selections tailored to said user, said interactive wizard guide comprising:

means for prompting the user to specify preferences regarding at least one type of merchandise of interest to said user, said prompting means includes means for prompting the user to answer a plurality of questions,

means for receiving the preferences and answers to the plurality of questions to create a user profile,

means for searching in and retrieving data from at least one database using predetermined intelligence rules together with said user profile to determine said recommendations and said selections of said merchandise and accessories to said merchandise,

means, in response to said retrieving means, for displaying on said display device, said recommendations and said selections of said merchandise and said accessories, and

means for overriding said interactive wizard guide.

This claim is directed to an electronic system that comprises an interactive wizard guide. The interactive wizard guide can be selectively and optionally deployed by the user of the system for making online purchasing recommendations tailorized (i.e., tailored) to the user. The interactive wizard guide can be overridden.

Danish does not teach or suggest means for overriding the wizard guide.

Danish also fails to disclose or suggest means for receiving the user's preferences and answers to questions to create a profile of the user, or means for searching in and retrieving data from a database using predetermined intelligence rules together with the profile to determine the recommendations, as is recited in claim 1.

We have argued this point in the Amendment filed on 7/22/2005. In response, the Final Office Action asserted (at page 9) that the phrase "create user profile" means "any information that is saved (even temporarily) from a user session." The Final Office Action then cited Danish at column 3, lines 50-65, as disclosing "assisted user searching." It appears that the "assisted user searching"

was intended as a disclosure of *means for searching in and retrieving data from at least one database using predetermined intelligence rules together with said user profile to determine said recommendations and said selections*, recited in claim 1. We take issue with these assertions for a number of reasons.

A *user profile* created from the preferences and answers provided by the user is not the same as *any information that is saved from a user's session*. Such broad definition of *user profile* is contrary to the language of claim 1, and has no basis in either the specification of the present application, or the English language.

Note that claim 1 recites “means for receiving the preferences and answers to the plurality of questions to create a user profile.” Thus, the profile is created using the answers provided by the user and the preferences that are specified by the user (see the “means for prompting” clause of claim 1). The *user profile* is not just “any” information stored from a user's session. Danish does not teach means for creating a profile of the user from the preferences specified by the user and answers to the questions provided by the user, or using the user profile so created to determine recommendations.

Danish's text cited by the Final Office Action as disclosing the “user assisted searching” reads as follows:

It is a further object of the present invention to provide an automated search method that can guarantee identification of at least one item for each search.

It is a feature of the present invention that a user is assisted in identifying a subfamily of items within a family of items by: providing a computer readable data file of stored information representing at least one family of items, the data file identifying at least one alternative for each item, reading the data file, displaying a feature screen indicating said alternatives represented in the family, accepting

selected alternatives, determining the subfamily of items where each item in the subfamily satisfies the selected alternatives, determining available alternatives represented in the subfamily and unavailable alternatives unrepresented in the subfamily, and revising the feature screen indicating the available alternatives as distinct from the unavailable alternatives.

Danish, col. 3, lines 49-65. The “items” and “alternatives” in Danish are not identified based on the stored user profile. Furthermore, Danish defines a family “as a collection of offerings with specific qualifiers and/or attributes,” see column 5, lines 48-49. The user of the Danish’s system delineates the family of items of interest through a menu, which may include Alphabetical Search, Picture Search, View Catalog, or Get Part Number Information methods. Danish, col. 5, line 54-61. These methods are further described in Danish, col. 5, line 67 *et seq.* Allowing a user to make selections based on product qualifiers and attributes (alphabetical, picture, catalog, P/N description) is not the same as using the user’s profile to determine recommendations. For example, Danish’s search is an interactive, iterative process during which the user makes selections. *E.g.*, Danish, col. 8, line 66 through col. 9, line 16; *see also id.* at col. 16, lines 17-23 and 38-39. In contrast, the means for searching of claim 1 uses “said user profile to determine said recommendations” – inherently requiring the profile to have been created previously, *i.e.*, before the search. In Danish, however, the profile need not be created at all, because the selection process is interactive and iterative.

At least for these reasons, Applicant respectfully submits that the Final Office Action has not made a *prima facie* case of obviousness of claim 1, and that claim 1 is patentable over the art of record.

B. Rejection of Dependent Claim 2

The Final Office Action rejected claims 2, 6-8, 12-15, and 17-19 under 35 U.S.C. § 103(a) as being unpatentable over Danish in view of Official Notice and further in view of Weaver. According to the Final Office Action, “[i]t would have been obvious to a person having ordinary skill in the art to include in Danish the virtual modeling capabilities as taught by Weaver, because this type of preview allows the user to become more comfortable with the purchased articles when the transaction is done online (col 1, lines 15-20).”

In the preferred embodiment described by Danish, the product family searched is FASTON Receptacles-Uninsulated. Danish, col. 5, lines 42-45. More generally, Danish’s “family of items 1 could be any commercial product or service offering with a common set of features 5 and alternatives 6, associated therewith.” Danish, col. 5, lines 38-40 (underlining added for emphasis). Applicant respectfully submits that the motivation to supplement Danish with virtual clothes modeling of Weaver does not apply in the context of electrical connectors, which are not modeled in the same sense as clothing. Moreover, the motivation to combine offered by the Office Action apparently would not apply to commercial products, as opposed to clothing intended for personal use. Danish and Weaver should not have been combined.

The Final Office Action also asserted, at page 5, that “Danish teaches using artificial intelligence rules to match the merchandise with the accessories and producing a list of results (FIG 21-24).” Danish’s Figures 21-24 illustrate program flows for feature screen creation operations,

Search operation initiated from the feature screen, and feature screen revision operation. Danish describes the functions of the feature screen 9 in these words:

The feature screen 9, therefore, provides a guided search in that it presents terminology for the features 5 and the alternatives 6 to the user prior to a search.

. . . .

While in the feature screen 9, the user may select and deselect turning radiobuttons 23 and listbox entries 16 “on” and “off” as desired. In response to a user initiated signal to perform a search, the system retrieves information concerning which user selectors 16, 23 are turned ‘on’ and to which alternatives 6 the user selectors 16, 23 that are turned “on” relate. The alternatives 6 turned “on” are the selected alternatives 37 and constitute the selection criteria 14 used in the search to generate a subfamily 2.

Danish, col. 7, lines 36-55 (emphasis added). See also Figures 7-9, which show different views of the feature screen. This appears to be a disclosure of search/retrieval based only on user-selected criteria, rather than intelligence rules. Consequently, Figures 21-24 (which illustrate feature screen operations) also show such search/retrieval.

Danish’s Abstract is to the same effect. The feature screen has a series of groupings. Danish, the Abstract. “Each grouping represents a feature having a set of alternatives from which to select. Selected alternatives are used as a selection criteria in a search operation.” *Id.* (emphasis added). Thus, the feature screen is an interface allowing the user to select the desired feature choices for the connectors. The system then performs a search operation, and “[r]esults of the search operation is a revised feature screen indicating alternatives that remain available to the user for further selection and searching.” *Id.*

In performing the search operation from the feature screen, Danish's system (1) does not use intelligence rules, and (2) does not match the merchandise with the accessories. Instead, it searches based on explicit selections (search criteria) of the user, and it matches the selections to the available connectors.

Note further that claim 2 recites "a layout and schematics program for preparing and displaying a floor plan depicting merchandise selected by the user, wherein the dimensions and other architectural features of the floor plan are provided by the user." The Final Office Action asserted (at page 5) that "Weaver teaches a layout and schematics program for preparing and displaying a floor plan depicting merchandise selected by the user (FIG 7, analogous to mannequin trying on clothes)."

"Analogous" need not mean "obvious." An airplane's wing may be analogous to a helicopter's rotor; a vacuum tube may be analogous to a transistor; and a lighting bug may be analogous to the lightning. But the first member of each pair does not by itself make obvious the second member. Even components that are functionally or mechanically equivalent are not necessarily obvious in view of one another. MPEP § 2144.06 (citing *In re Scott*, 323 F.2d 1016, 139 U.S.P.Q. 297 (CCPA 1963)); *see also In re Mayne*, 104 F.3d 1339, 1342, 41 U.S.P.Q.2d 1451, 1454 (Fed. Cir. 1997).

A mere invocation of "analogous" does not serve as a substitute for a teaching or suggestion to modify or combine the references. Without this teaching, a *prima facie* case of obviousness cannot be made.

At least for these reasons, Applicant respectfully submits that the Final Office Action has not made a *prima facie* case of obviousness of claim 2, and that this claim is separately patentable over the references of record.

C. Rejection of Dependent Claim 4

Claim 4 depends from claim 1 and further recites “means for providing the user with names of a plurality of vendors for the merchandise recommended to the user.” In contrast to the plurality of vendors recited in claim 4, Danish’s system searches through products of a single vendor, AMP Incorporated. See, for example, Figures 1, 31-33, and 35. See also Figures 5, 7-10, and 26-30, which show products and the trade name FASTON®, a trademark of AMP Incorporated. Danish, col. 5, lines 42-45.

The Final Office Action argued that mere duplication of the essential working parts of a device involves only routine skill in the art, citing *St. Regis Paper Co. v. Bemis Co., Inc.*, 549 F.2d 833, 193 U.S.P.Q. 8 (7th Cir. 1977). The *St. Regis* opinion, however, is heavily fact-dependent. Danish’s searching through the database of a single known vendor is different from searching a network to find vendors who supply the merchandize that fits the user’s need. In Danish’s case, it appears that the user would need to know the location of each vendor’s website/database before searching, even if the system were adapted to search through multiple databases of multiple vendors.

These facts were not present in *St. Regis*. The Final Office Action neither compares the facts in *St. Regis* to the facts in this case, nor explains why, based on this comparison, the legal conclusion

here should be the same as in *St. Regis*. Instead, it appears that the Final Office Action relies on *St. Regis* as establishing a *per se* rule that duplication of parts or steps would have been obvious. But “reliance on *per se* rules of obviousness is legally incorrect and must cease.” *In re Ochiai*, 71 F.3d 1565, 1572, 37 U.S.P.Q.2d 1127, 1133 (Fed. Cir. 1995).

Reliance on a *per se rule* of obviousness was improper. At least for this reason, Applicant respectfully submits that the Final Office Action has not made a *prima facie* case of obviousness of claim 4, and that this claim is separately patentable over the references of record.

D. Rejection of Dependent Claim 6

Claim 6 depends from claim 1. According to the additional limitations of claim 6, the system further comprises means for preparing and displaying, based on specifications provided by the user, a recommended floor plan showing each item of merchandise selected by the user. Applicant respectfully submits that claim 6 is separately patentable over the references of record at least for the same reason as discussed above in relation to the “layout and schematics program” limitation of claim 2.

E. Rejection of Dependent Claim 9

Claim 9 depends from claim 1. According to the additional limitations of claim 9, “the retrieved data is stored in a local database which is smaller than the at least one database, thereby

enabling the user to interact with the system without having to traffic data through a network and thus at a faster speed than would be possible if the user had to traffic data through the network.”

Danish does not disclose or suggest storing the retrieved data in a smaller database, or storing the retrieved information in a local database, thereby enabling the user to interact with the system without having to traffic data through a network. Consider, for example, Danish’s Figure 25, which “is a representation of a server and client configuration and the flow of data therebetween.” Danish, col. 5, lines 6-7. Figure 25 shows FEATURE SCREEN STATUS 127 being transmitted from the SERVER 125 to the CLIENT 126, but does not show a smaller database being transmitted to the CLIENT 126. Moreover, Danish expressly states that “[a]ll of the program files and data files described in the local embodiment reside on the server 125.” Danish, col. 18, lines 38-39. Danish also includes the following paragraph in the description of the operation of the Internet-based embodiment, which shows how the data are trafficked through the network:

The client 126 initiates a request to the server 125 for the electronic catalog searching application via the Internet. The server 125 detects the request. Receipt of the request executes the requested application on the server 125 that permits a user on the client 126 to select a family 1 or subfamily 2. Example of Main Menu, Alphabetical search, Picture Search, and View Part Number screens are shown in FIGS. 31 through 35. When the family 1 or subfamily 2 is chosen, the server 125 sends a feature screen status 127 to the client 126. The feature screen status 127 comprises a feature screen code, ScreenNum 102 in a preferred embodiment, all features 5 appropriate to the feature screen 9 specified in ScreenNum 102, all available alternatives 7, all unavailable alternatives 8, and the selection criteria 14. As the selection criteria 14 is always sent, it may comprise zero selected alternatives 37. It is apparent, therefore, that the server 125 sends all of the information necessary to define the current subfamily 2 to the client 126. The information, therefore, need not be retained in memory on the server 125. This particular feature renders it particularly appropriate for an Internet environment. The client 126 receives the feature screen status 127 and displays the feature screen 9 accordingly. An example of the feature screen 9 on the Internet is shown in FIG. 26 through 29. The user on the client, makes selections from among the available alternatives 7 generating a selection criteria 14 different from that which was set to it. The client 126 initiates a

search with the modified selection criteria 14. The client 126 sends to the server 125, the ScreenNum 102 value sent to it by the server, and the modified selection criteria 14. The server 125 receives the ScreenNum 102 and the selection criteria 14. The server 125 executes the search operation as disclosed hereinabove using the revised selection criteria 14 and generates the feature screen status 127. The server 125 sends the feature screen status 127 that has been updated based on the modified selection criteria 14 to the client 126. The client 126 receives the feature screen status 127 and displays the updated feature screen 9. This process may iterate similar to the local version to further narrow the subfamily as desired.

Danish, col. 19, lines 1-39 (underlining added for emphasis). Thus, in Danish, the data are trafficked through the network for each search iteration.

The Final Office Action disregarded the following limitation recited in claim 9: “thereby enabling the user to interact with the system without having to traffic data through a network and thus at a faster speed.” But to make a *prima facie* case of obviousness, the prior art references “must teach or suggest all the claim limitations.” MPEP § 2143.

At least for these reasons, Applicant respectfully submits that the Final Office Action has not made a *prima facie* case of obviousness, and claim 9 is separately patentable over the references of record.

F. Rejection of Dependent Claim 19

With respect to claim 19, the Final Office Action asserted that “[i]t was old and well known in the art . . . to be able to retrieve additional items that may not be on a provided list (i.e. adding to a shopping cart).” The issue, however, is not whether it was known to add items to a shopping cart,

but whether it was obvious to add matching items to an array of recommendations. The prior art of record does not disclose or suggest this limitation.

We have made this argument before. In response, the Final Office Action stated (at page 11) that the shopping cart is used “to indicate that a list can be updated by selecting additional products to be added.” Our point, however, is that claim 19 recites that the user can specify additional matching items to be added to an array of recommendations presented to the user. In Danish, the user goes through an interactive/iterative selection and search process. The user makes selections of search criteria (qualifiers and attributes), and obtains search results. Apparently, the user does not directly add items to such search results, but rather through changing (broadening) search criteria and obtaining new search results. *See, e.g., Danish, col. 22, lines 12-20 (Danish’s claim 8).*

Applicant respectfully submits that the Final Office Action failed to make a *prima facie* case of obviousness of claim 19, and that claim 19 is separately patentable over the references.

G. Rejection of Dependent Claims 20 and 21

The Final Office Action does not address the additional limitations recited in claim 20.

With respect to claim 21, the Final Office Action acknowledged that Danish and Weaver do not specifically teach the predetermined intelligence rules that pertain to determining whether two colors match. The Final Office Action then sought to supplement Danish, Official Notice, and Weaver with disclosure made in Hashimoto. To justify such combination, the Office Action asserted that it would have been obvious to combine Danish and Weaver with Hashimoto “because this

would provide an additional feature that users, perhaps color blind or lacking in taste, could use to assure that the clothing being bought matches.” Note, however, that claim 21 depends from claim 20, in accordance with “the override means includes means to allow the user to override a predetermined intelligence rule.” Even if the rationale offered in the Final Office Action in support of combining the references suggested employing a color coordination rule, it does not explain why the system would allow the user to override this rule, as recited in claim 20, from which claim 21 depends. Indeed, it appears that the rationale offered by the Final Office Action in support of the rejection of claim 21 is inconsistent with overriding the rule, which limitation must be read into the dependent claim 21.

At least for this reason, Applicant respectfully submits that the Final Office Action failed to make a *prima facie* case of obviousness of claims 20 and 21, and this claim is separately patentable over the references.

VIII
CONCLUSION

For the foregoing reasons, Appellant respectfully submits that all pending claims are patentable over the references of record and respectfully requests reversal of the rejections.

Respectfully submitted,

Dated: June 14, 2006

A handwritten signature in dark ink, appearing to read "Anatoly S. Weiser", written over a horizontal line.

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CLAIMS APPENDIX

The following is a listing of the claims in the application. All claims have been rejected and are involved in this Appeal.

1. (Previously Presented) An electronic system for purchasing merchandise online using a computer having a display device, comprising:

means for selecting and purchasing merchandise, by a user, online; and

an interactive wizard guide, selectively and optionally deployed by the user, for making online merchandise recommendations and computer-assisted selections tailored to said user, said interactive wizard guide comprising:

means for prompting the user to specify preferences regarding at least one type of merchandise of interest to said user, said prompting means includes means for prompting the user to answer a plurality of questions,

means for receiving the preferences and answers to the plurality of questions to create a user profile,

means for searching in and retrieving data from at least one database using predetermined intelligence rules together with said user profile to determine said recommendations and said selections of said merchandise and accessories to said merchandise,

means, in response to said retrieving means, for displaying on said display device, said recommendations and said selections of said merchandise and said accessories, and

means for overriding said interactive wizard guide.

2. (Previously Presented) The system according to Claim 1, wherein:

said prompting means comprises:

a questionnaire database that prompts the user to answer a plurality of questions to specify the user preferences with regard to the at least one type of merchandise;

said searching and retrieving means comprises:

a search engine using comparison functions, said intelligence rules and user input rules;

said wizard guide further comprising:

a merchandise database having textual and graphical data regarding the at least one type of merchandise, the merchandise database using said intelligence rules to match the merchandise with the accessories and having links to databases for other types of merchandise;

a layout and schematics program for preparing and displaying a floor plan depicting merchandise selected by the user, wherein the dimensions and other architectural features of the floor plan are provided by the user;

a models database having images of models;

an animation and morphing program for providing image and motion creation and morphing to models selected from the model database by the user, wherein the selected models wear merchandise selected by the user, the user able to alter the models and the models' features;

a temporary working database in which the user works while using the system; and

a personal folder database for storing the data from the temporary working database and said

user profile.

3. (Previously Presented) The system according to Claim 1, wherein the user specifies the user preferences by either checking at least one box in front of a possible choice or clicking on a text string representing that choice.

4. (Previously Presented) The system according to Claim 1, further comprising:
means for providing the user with names of a plurality of vendors for the merchandise recommended to the user.

5. (Previously Presented) The system according to Claim 4, further comprising:
means for enabling the user to select a vendor from the plurality of vendors;
means, responsive to the selected vendor, for prompting the user to specify additional information regarding products of the selected vendor.

6. (Previously Presented) The system according to Claim 1, further comprising:
means for preparing and displaying, based on specifications provided by the user, a recommended floor plan showing each item of merchandise selected by the user.

7. (Previously Presented) The system according to Claim 6, further comprising:
means for prompting the user to examine and specify specifications and configurations for

each merchandise item.

8. (Original) The system according to Claim 7, wherein the user uses an input device to click on an individual item of merchandise shown on the display device to determine which goods to configure.

9. (Previously Presented) The system according to Claim 1, wherein the retrieved data is stored in a local database which is smaller than the at least one database, thereby enabling the user to interact with the system without having to traffic data through a network and thus at a faster speed than would be possible if the user had to traffic data through the network.

10. (Previously Presented) The system according to Claim 1, wherein the prompting means includes menus and data entry tables to solicit said preferences from the user.

11. (Canceled)

12. (Previously Presented) The system according to Claim 1, wherein the interactive wizard guide includes: means for selecting a model from a model database and morphing the model using specifications provided by the user.

13. (Original) The system according to Claim 12, wherein the interactive wizard guide uses

an animation graphics composition morphing program to cause the model to be animated and to engage in a full range of movement displayed on the display device.

14. (Previously Presented) The system according to Claim 1, wherein the interactive wizard guide includes both inclusion and exclusion mechanisms to assist the user in making preference selections.

15. (Previously Presented) The system according to Claim 1, wherein the interactive wizard guide includes an automated select all feature wherein all possible preferences are automatically included unless excluded by the user.

16. (Previously Presented) The system according to Claim 1, wherein at any stage of interaction with the system, an array of recommendations can be presented on the display device, the array able to be narrowed or enhanced interactively as the interactive wizard guide gains input from the user.

17. (Previously Presented) The system according to Claim 1, wherein if the merchandize is clothing, the displaying means of the interactive wizard guide can display a plurality of ensembles of clothing for viewing by the user, each ensemble able to be altered with ensemble items moved from one ensemble to another, colors and patterns changed, and reassembled interactively, the ensembles able to be displayed using models and animation specified by the user.

18. (Previously Presented) The system according to Claim 17, wherein the user can purchase an entire ensemble, or any part of the ensemble.

19. (Original) The system according to Claim 16, wherein the user can specify additional desired matching items to be retrieved and displayed for viewing that may not be included in the array.

20. (Previously Presented) The system according to Claim 1, wherein the override means includes means to allow the user to override a predetermined intelligence rule used by the interactive wizard guide to make recommendations to the user.

21. (Previously Presented) The system according to Claim 20, wherein the predetermined intelligence rule pertains to determining whether two colors match.

22. (Withdrawn) The system according to Claim 1, wherein the retrieved data is stored in both (1) a local database of a server, and (2) a second database on the server which is smaller than the at least one database, thereby enabling the user to interact with the system without having to traffic data through a network and thus at a faster speed than would be possible if the user had to traffic data through the network.

EVIDENCE APPENDIX

No evidence has been submitted pursuant to 37 C.F.R. §§ 1.130, 1.131, or 1.132. No evidence has been entered in the record by the Examiner and relied upon by Appellant in this Appeal.

RELATED PROCEEDINGS APPENDIX

Applicant-Appellant and the undersigned legal representative do not know of any other appeal, interference, or judicial proceeding that is related to, directly affects, is directly affected by, or has a bearing on the decision of the Board of Patent Appeals and Interferences in this Appeal.